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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

019213-0311422

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Application Number

09/732,008

Filed

December 8, 2000

First Named Inventor

Paul H. ROBB

Art Unit

3691

Examiner

Kelly Scaggs Campen

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/98)

☒ attorney or agent of record.
Registration number 58,780

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature

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July 6, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPELLANT :	Paul H. ROBB	CONFIRMATION NO. :	1665
SERIAL NUMBER :	09/732,008	EXAMINER :	Kelly Scaggs Campen
FILING DATE :	December 8, 2000	ART UNIT :	3691
FOR :	METHOD AND SYSTEM FOR COLLABORATING ADVISORS		

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In response to the Final Office Action mailed April 13, 2010 (hereinafter "Final Action") in the above-referenced application, Appellant hereby requests a review of the Final Action for at least the reasons set forth below. This request, being filed concurrently with a Notice of Appeal, has a total of 5 pages. Appellant believes that no extensions of time or fees are due beyond those otherwise provided for in documents accompanying this paper. However, if additional extensions of time or other fees are due, the Director is authorized to charge the same to our Deposit Account No. 033975 (Ref. No. 019213-0311422).

MOOT OBJECTIONS AND REJECTIONS

The Examiner has objected to the Abstract under MPEP § 608.01(b) as allegedly including language that "may be implied (for example, 'the invention provides'"). For at least the reason that Appellant's response filed July 10, 2006 amended the Abstract to delete the language previously reciting the term "invention," Appellant requests that the objection to the Abstract be withdrawn.

In addition, the Examiner provisionally rejected claims 1-37 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-56 of co-pending Application Serial No. 09/877,926 ("the '926 Application"). Appellant is filing herewith a Terminal Disclaimer with respect to the '926 Application, rendering this rejection moot, and therefore requests that this rejection be withdrawn.¹

REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

The Examiner has rejected claims 1-41 under 35 U.S.C. § 112, second paragraph, as allegedly reciting various terms that are indefinite. In particular, the Examiner alleges that there is no clear definition for the claim terms "collaborate," "enabling," "to interact," "events," and "actions," and further alleges that the "terms 'clients' and 'participants' are confusing since the relationship between the two is not recited."

¹ Appellant notes that filing a Terminal Disclaimer to obviate a non-statutory double patenting rejection is not an admission that the rejection is proper. *Quad Envtl. Tech. Corp. v. Union Sanitary Dist.*, 946 F.2d 870 (Fed. Cir. 1991).

Appellant traverses this rejection because the each of these terms has a well understood plain meaning, particularly in light of Appellant's disclosure. Additionally, Appellant has previously provided several exemplary citations to the disclosure to further clarify the scope and meaning of the challenged claim terms, which are reiterated and further clarified herein.

In particular, "financial services provider participants" (or "authorized participants") may "collaborate" with one another and/or with a "financial services client" to provide one or more services for the "financial services client." For example, the "financial services provider participants" may "collaborate" in a cohesive team that can share data, devise a plan, address client concerns, draft or modify documents, or otherwise work together to "collaborate" in providing the services for the "financial services client" (e.g., pg. 4, line – pg. 8, line 21). In this context, the claims recite an "electronic collaboration tool" "enabling" the financial services provider participants to receive authorization to access data belonging to the financial services client, "enabling" the client and the authorized participants to submit client data to the electronic collaboration tool, "enabling" the client to request particular services from the financial services provider participants, and "enabling" interaction among the client and the financial services provider participants, thereby "enabling" the financial services provider participants to provide the requested services for the client (e.g., pg. 9, line 1 – pg. 12, line 5). Furthermore, the client may define certain "triggering events" that result in notifications when such events occur (e.g., pg. 13, line 16 – pg. 17, line 19).

Thus, the financial services provider participants and the financial services client may "collaborate" and "interact" with one another through the "electronic collaboration tool" to enable the financial services provider participants to provide the requested services for the financial services client. The commonly understood plain meanings for these terms provides further context for the relationship between the "client" and "participants," in that the "electronic collaboration tool" enables the "financial services client to request one or more services from the financial services provider participants." That is, the "authorized participants" provide financial services for the client, where authorizing access to the client data for the financial services provider participants, maintaining databases to store the data, and enabling interaction through the collaboration tool enables the "authorized participants" to provide requested financial services providers on behalf of the client (e.g., pg. 12, line 6 – pg. 17, line 7).

Accordingly, for at least the reason that each of the foregoing claim terms has a commonly understood plain meaning, especially in light of the exemplary citations to Appellant's disclosure provided above, the claim terms challenged by the Examiner do not render claims 1-41 indefinite. For at least this reason, Appellant requests that this rejection be withdrawn.

REJECTION UNDER 35 U.S.C. § 101

The Examiner has rejected claims 1-41 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Appellant traverses this rejection because the method recited in claims 1-19 and 39-41 are sufficiently tied to a particular machine that carries out the functionality further recited therein, and because the system recited in claims 20-38 are not directed to "functional descriptive material" or a transitory "signal." More particularly, the Examiner alleges that "claims 1-19 and 39-41 recite a process

comprising the steps of enabling and storing,” which the Examiner alleges are neither tied to a machine or transform underlying subject matter to a different state or thing” because the further recitations to a particular machine “does not involve more than insignificant extra solution activity.”

However, in *Bilski v. Kappos*, 561 U.S. ____ (2010), the Supreme Court recently rejected the test applied by the Examiner, holding that the “machine-or-transformation test is not the sole test for deciding whether an invention is a patent-eligible process” and that “federal law explicitly contemplates the existence of at least some business method patents” provided that the claims are not directed to “abstract ideas.” Thus, the rejection with respect to claims 1-19 and 39-41 is improper for at least the reason that the Examiner has applied a test that has recently been rejected by the Supreme Court as providing the sole criteria for determining whether a claimed “process” recites statutory subject matter. Nonetheless, even under this test, the Examiner appears to concede that the claims indeed recite “a particular machine,” while improperly alleging that the particular machine recited therein constitutes “insignificant extra solution activity” because the claims recite “an information processing” hosting an “electronic collaboration tool” and having various technical mechanisms that enable the functionality further recited therein (e.g., “network communication links” that enable communication with the collaboration tool, “one or more databases” that store data used to provide financial services through the collaboration tool, etc.). Accordingly, for at least the reason that the method recited in claims 1-19 and 39-41 recite various features that tie the claims to a particular machine, or alternatively do not merely recite an “abstract idea,” the rejection with respect to claims 1-19 and 39-41 is improper and must be withdrawn.

Furthermore, with respect to the system recited in claims 20-38, the Examiner alleges that the claims appear to recite “functional descriptive material (code per se)” and further alleges that the claims appear to recite “the code on a signal.” These allegations are incorrect because Appellant’s disclosure clearly states that “an information processing hub” includes, among other things, various “multiprocessor computers, operating systems, relational databases, workflow processing systems, Internet Web servers and other elements.” E.g., Appellant’s disclosure, pg. 22, line 3 – pg. 24, line 16. Thus, although the electronic collaboration tool recited in claims 20-38 may include software or other computer programs that realize the functionality recited therein, claims 20-38 recite a system that includes “an information processing hub . . . [that] includes one or more *processing systems*,” which are described in Appellant’s disclosure as being multiprocessor computers or other tangible systems. Accordingly, for at least the reason that the system recited in claims 20-38 recite various tangible hardware elements, which are not solely directed to “functional descriptive material” or “code [hosted] on a signal,” the rejection with respect to claims 20-38 is improper and must be withdrawn.

REJECTION UNDER 35 U.S.C. § 103

The Examiner has rejected claims 1-7, 9-17, 19-26, 28-36, and 38-40 under 35 U.S.C. § 103 as allegedly being unpatentable over U.S. Patent No. 5,940,843 to Zucknovich (“Zucknovich”), and has further rejected claims 8, 18, 27, 37, and 41 under 35 U.S.C. § 103 as allegedly being unpatentable over Zucknovich in view of U.S. Patent No. 6,243,722 to Day et al. (“Day”). Appellant traverses these rejections because

neither Zucknovich nor Day qualifies as analogous art and because Zucknovich and Day, either alone or in combination, fail to disclose, teach, or suggest each and every feature of the claimed invention.

In particular, Zucknovich does not qualify as analogous art because Zucknovich has a different field of endeavor and addresses different problems from the claimed invention. Specifically, Zucknovich's field of endeavor relates to research contributors generating reports that are then distributed to investors, whereas the claimed invention operates in a field of endeavor that relates to financial services provider participants interacting with a collaboration tool to provide collaborative financial services for a particular financial services client using shared data belonging to the client. For example, the reports described in Zucknovich cannot be considered reasonably analogous to the "client data" recited in the claims because such "client data" is specific to the client, wherein authorized participants may access the client data to provide requested services for the client. In contrast, the research reports described in Zucknovich concern third parties rather than the contributors that generate the reports or the investors that receive the reports.

As such, because the content of the reports do not relate to either the contributors or recipients of the reports, Zucknovich does not operate in a field of endeavor that relates to financial services providers interacting with a collaboration tool to provide collaborative financial services for a financial services client, much less the particular problem relating to controlling the providers' access to the data when such providers deliver the relevant services to the client. For similar reasons, because the content of the reports described in Zucknovich do not relate to either the contributors or recipients of the reports, Zucknovich does not disclose, teach, or suggest the claim features that relate to "enabling authorization of one or more participants to access client data" and "enabling interaction among the financial services client and the financial services provider participants [and] among the authorized participants, wherein the enabled interaction includes an exchange of the client data stored in the one or more databases," as recited in independent claim 1, for example.

Furthermore, Day also does not qualify as analogous art because Day has a field of endeavor and addresses particular problems that are fundamentally different from those of the claimed invention. Specifically, Day has a field of endeavor that relates to "assisting users in collectively creating documents . . . via the computer network." However, merely being concerned with viewing documents over a network does not bring Day with Appellant's field of endeavor, which relates to providing client-specific services and advice through interaction among clients and their financial services providers, much less the particular problem relating to controlling the providers' access to the data when such providers deliver the relevant services to the client and enabling a consistent, accurate, and secure exchange of client data among the authorized participants and the client when the authorized participants provide collaborative services for the client. For similar reasons, because Day does not relate to enabling collaborative features between financial services clients and authorized participants, Day fails to disclose, teach, or suggest the foregoing features that relate to this context, as recited in independent claim 1, for example.

In response to Appellant's arguments addressing these issues, the Examiner alleges that "Zucknovich discloses data exchange . . . to participants (researchers) and interaction in the form of discussing the research reports." The Examiner further alleges that the "terms 'interact' and 'exchange' are

given the broadest possible meaning." These allegations are improper because they are broad and conclusory in nature, lacking any evidence to support that Zucknovich discloses a data exchange that relates to "client data," and further because the allegations entirely fail to address Appellant's arguments with respect to Day. Furthermore, the Examiner has improperly given the claim terms "the broadest possible meaning," as the correct standard is a "broadest *reasonable* interpretation in light of the disclosure." For at least these reasons, the Examiner's arguments in the Final Office Action fail to cure the deficiencies of the rejections noted above.

Accordingly, for at least the foregoing reasons, Zucknovich and Day are neither in Appellant's field of endeavor nor pertinent to the problem with which Appellant was concerned, nor do Zucknovich and Day, either alone or in combination, disclose, teach, or suggest each and every feature of the claimed invention. The rejections based on Zucknovich and Day therefore fail for at least these reasons.

CONCLUSION

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Date: July 6, 2010

Respectfully submitted,

By:



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